

REMARKS

Reconsideration and allowance of the present application are respectfully requested. Claims 1-6, 8-10 and 12-48 are currently pending in this application. Claims 20-37 and 48 are currently withdrawn from consideration.

Regarding the Propriety of Entry of this Response Under 37 C.F.R. § 1.116

In the present Response, the claims have been amended to more consistently use the phrase "configured to." That is, prior to the amendment, the claims used the phrase "configured to" in many instances, but sometimes used the term "to" as an abbreviated form of "configured to"; in this Response, the term "to" has been changed to "configured to." Other changes have been made to the claims in direct response to the Examiner's objections and rejections regarding the clarity of the claims. In general, the amendments presented herein are believed to place the application in condition for allowance by clearly distinguishing the claimed invention over the applied references; alternatively, in the very least, these amendments are believed to place the application in better form for appeal. Accordingly, entry of this Response under 37 C.F.R. § 1.116 is appropriate and is respectfully requested.

Regarding the Restriction Requirement

It is the present intention of the Applicant to file a divisional application to pursue the withdrawn claims 20-37 and 48.

Regarding the Objection to the Specification

In paragraph No. 8 of the Office Action, the Patent Office objects to the specification because it allegedly fails to provide antecedent basis for the element in

1 claim 1 which previously recited: "wherein the communication involves transferring
2 information to subscribers in advance of receiving requests from the subscribers
3 pertaining to the information. . . ." The Applicant respectfully traverses this objection
4 because the specification provides abundant support for this element (as will be discussed
5 below). Nevertheless, to assist the Examiner, this Response amends the element in
6 question to recite: "wherein the publishing component is configured to perform the
7 communication by transferring information to subscribers in advance of receiving
8 requests from the subscribers to modify the information. . . ." The following explanation
9 will identify exemplary support for both the original element identified in the Office
10 Action and its amended counterpart (as presented herein). At the outset, it should be noted
11 that reference to the specification is being made to point out non-limiting examples which
12 are *encompassed* by the claim language; however, the claim language is not limited by
13 the examples set forth in the specification.

14 First consider the following excerpts taken from pages 4-6 of the specification:
15

16 The various subscribers 104 register, with the publishing component 110, their specific
17 criteria that identifies the particular information in the information tracking database of component
18 106 that they want to receive (page 4, lines 25-28).

19 . . .

20 The publishing component 110 uses the different criteria it receives from the subscribers
21 104 to determine which information from the information tracking component 106 to
22 communicate to the individual subscribers. The publishing component 110 effectively filters the
23 information from the information tracking component 106 and publishes to each subscriber 104
24 only the information that satisfies that subscriber's criteria (page 5, lines 10-15).
25

1 The subscribers 104 receive the published information from the publishing component
2 110, and then use the received information in whatever manner they desire. Typically, the
3 subscribers 104 store the received information locally for subsequent user accesses (page 5, lines
4 16-19).

5 ...

6 The subscribers 104 can also communicate requests regarding the information
7 communicated (published) to them back to the system 102 via a subscriber request component
8 112. These requests cause the system 102 to alter the information stored in the tracking
9 component 106, such as a request from one of the subscribers 104 to purchase an asset published
10 to that subscriber. These subscriber requests are received by the subscriber request component
11 112 and processed to bring about the alterations to the information stored in the tracking
12 component 106. The publishing component 110 then communicates the changes to the
13 subscribers 104 that have registered for that information. Thus, any changes made to information
14 in the database of tracking component 106 are propagated out (via the publishing component 110)
15 to the various subscribers 104 affected by the change (page 6, lines 1-12).

16
17 Related subject matter is also described in the context of the flowchart shown in
18 Fig. 7 (with emphasis added):

19
20 In block 702, information regarding multiple items is stored in a tracking database. *In*
21 *block 704, selected information from the tracking database is communicated to particular*
22 *subscribers based on the subscriber criteria, and in block 706 information regarding which item*
23 *information has been communicated to which subscribers is stored in a publishing database. In*
24 *block 708, a request to change information for a particular item is received from a subscriber. In*
25 block 710, the item information is updated in the publishing database in accordance with the

1 request, and in block 712 the subscribers that previously received the item information are
2 identified (e.g., based on the information in the publishing database). In block 714, the change to
3 the item information is communicated to the subscribers identified in block 712 (page 25, lines 18-
4 28, emphasis added).

5
6 These passages specify, with complete clarity, that the publication component 110
7 transfers information to a subscriber (in step 704) in advance of the subscriber generating
8 a request regarding the information (in step 708). More specifically, step 704 obviously
9 occurs before, or, in other words, "in advance of," step 708. The above-identified
10 element in claim 1 (in both its original wording and its current wording) therefore finds
11 antecedent basis in the specification. And for this reason, the Applicant respectfully
12 requests that the objection to the specification in paragraph No. 8 of the Office Action be
13 withdrawn.

14
15 *Regarding the 35 U.S.C. § 112, First Paragraph, Rejection*

16 Claims 1-6, 8-10, 12-19 and 38-47 were rejected under 35 U.S.C. § 112, first
17 paragraph, as failing to comply with the written description requirement. More
18 specifically, paragraph Nos. 10 and 11 of the Office Action state that the claims are
19 deficient because they fail to reasonably convey to one skilled in the relevant art that the
20 inventors had possession of the claimed invention at the time the application was filed.
21 The Office Action specifically states that the written description requirement is not met
22 with respect to the above-discussed element of claim 1 ("wherein the communication
23 involves transferring information to subscribers in advance of receiving requests from the
24 subscribers pertaining to the information. . ."). The Applicant respectfully traverses this
25 rejection, since the instant specification makes it abundantly clear that the inventors had

1 possession of the claimed subject matter at the time the application was filed; this is true
2 with respect to both the original element in question, as well as its amended counterpart
3 identified above.

4 For example, the above-identified passages from the specification clearly set forth
5 that the publication component 110 transfers information to a subscriber (in step 704) in
6 advance of the subscriber generating a request regarding the information (in step 708).
7 This provides direct support for the element in claim 1 identified in the Office Action. It
8 is true that there is not a word-for-word equivalent for this claim element, but this is not a
9 legal requirement. For instance, *as stated in MPEP § 2163.02, the subject matter of the*
10 *claim need not be described literally (i.e., using the same terms or in haec verba) in*
11 *order for the disclosure to satisfy the description requirement.* For these reasons, the
12 Applicant respectfully requests that the Patent Office withdraw the 35 U.S.C. § 112, first
13 paragraph, rejection.

14
15 *Regarding the 35 U.S.C. § 112, Second Paragraph, Rejection*

16 Claims 1-6, 8-10, 12-19 and 38-47 were rejected under 35 U.S.C. § 112, second
17 paragraph, as failing to particularly point out and distinctly claim the subject matter
18 which Applicant regards as the invention. Applicant respectfully traverses this rejection
19 for the following reasons.

20 Paragraph Nos. 14-16 set forth three separate bases for the. § 112, second
21 paragraph, rejection. Changes have been made to claim 1 to address each of the issues
22 raised by the Examiner. The changes made to address the issues made in paragraph Nos.
23 14 and 16 are believed to be self-explanatory.

24 As to paragraph No. 15, the Office Action again points out the above-identified
25 element of claim 1 ("wherein the communication involves transferring information to

1 subscribers in advance of receiving requests from the subscribers pertaining to the
2 information. . ."). Namely, in paragraph No. 15, the Office Action states that this
3 element is indefinite. More specifically, the Patent Office specifically states:

4
5 It is the Examiner's position that this is an impossible limitation since the transferred
6 information must always 'pertain' to the request submitted by the subscriber. Unless the publisher
7 can somehow guess, this limitation will never occur.

8
9 This statement reflects a misunderstanding of the nature of the invention. As
10 discussed above, the specification describes that the publication component 110 uses pre-
11 established criteria to send selected information to the local storage of a subscriber. The
12 subscriber then enters a request based on that information. This request modifies the
13 information, such as by changing the status of the information. In this manner, the
14 publication component 110 transfers information to subscribers *in advance of* the
15 subscribers taking actions (e.g., making requests) that pertain to the information. Of
16 course, the specification provides *support* for the claims, and should not be used to limit
17 the claims; but the explanation provided here at least demonstrates that the claim element
18 in question is certainly not "impossible." More specifically, the Examiner's statement
19 that "transferred information must always 'pertain' to the request submitted by the
20 subscriber" is factually misplaced; as stated, the publication component 110 *does* send
21 information to a subscriber (in step 704) before the subscriber makes a request regarding
22 that information (in step 708). In any event, amendments have been made to claim 1 to
23 help clarify the subject matter recited therein and to thereby advance prosecution.

24 For the above-identified reasons, the Patent Office is respectfully requested to
25 withdraw the 35 U.S.C. § 112, second paragraph, rejection.

1 *Regarding the 35 U.S.C. § 102 Rejections*

2 Claims 1-6, 8-10, 12-19 and 38-47 are rejected under 35 U.S.C. § 102(b) as being
3 anticipated by U.S. Patent No. 5,835,896 to Fisher et al. (referred to below as "Fisher").
4 Applicant respectfully traverses this rejection for the following reasons, in conjunction
5 with the more expanded explanation set forth in the July 16, 2004 Response (which is
6 incorporated here by reference).

7 Amended independent claim 1 is reproduced below for the convenience of the
8 Examiner:

9
10 1. A system comprising:

11 an information tracking component configured to store, for each of a plurality of items,
12 information describing the item;

13 a supply component configured to receive data describing one or more items and store the
14 converted data as information in the information tracking component;

15 a publishing component configured to select, based on pre-established selection criteria,
16 for each of a plurality of subscribers, a set of information from the information tracking
17 component, and to communicate the selected set of information to local storage maintained by the
18 subscriber, wherein the publishing component is configured to perform the communication by
19 transferring the information to subscribers in advance of receiving requests from the subscribers to
20 modify the information; and

21 a subscriber request component configured to receive requests from the plurality of
22 subscribers and modify the information stored in the information tracking component in
23 accordance with the requests,

24 wherein the publishing component is further configured to identify one or more of the
25 plurality of subscribers affected by the modification to the information stored in the information

1 tracking component, and to communicate, to the one or more of the plurality of subscribers
2 affected by the modification, the information as modified.
3

4 Fisher does not teach or suggest the above-described recitations of claim 1. More
5 specifically, Fisher discloses an electronic auction system including a merchandise
6 catalog page generator 25 for generating catalog pages that describe merchandise that
7 may be bided upon using the system. Upon accessing the catalog page, a bidder may
8 press a button on the catalog page or take some similar action that causes a bid form to be
9 displayed on the screen. The bidder then enters information necessary to place a bid. A
10 bid validator 21 examines the entered bid information to ensure that the bid is properly
11 formatted. If so, the system stores bid information in a bid database 31. An auction
12 manager 26 queries the bid database 31 to determine if any new bids have been placed. If
13 new bids are found during the query, the auction manager 26 calculates the current high
14 bidder or bidders and instructs merchandise catalog page generator 25 to regenerate a
15 catalog page with the updated bid information. Further, an electronic mail messenger 27
16 queries bid database 31 for bids recently marked by auction manager 26 as having been
17 outbid or having won an item in a recently closed auction. If such bids are found, the
18 electronic mail messenger 27 formats an appropriate electronic mail notification message
19 24 and sends this message to the user. See generally column 6, line 13 to column 8, line
20 29 of Fisher.

21 Fisher's system is unlike the system recited in claim 1. For example, Fischer does
22 not disclose at least the following element of claim 1 (in the context of claim 1
23 considered as a whole): "a publishing component configured to select, *based on pre-*
24 *established selection criteria*, for each of a plurality of subscribers, a set of information
25 from the information tracking component, and to communicate the selected set of

1 information to local storage maintained by the subscriber, wherein the publishing
2 component is configured to perform the communication by *transferring the information*
3 *to subscribers in advance of receiving requests from the subscribers to modify the*
4 *information.* First, Fisher's catalog-browsing feature comprises a conventional type of
5 manual search that does not involve selection using pre-established criteria. Second,
6 Fisher's apparatus presumably sends information to bidders *in the course of the bidders*
7 *making bids on merchandise (which modifies the status of the merchandise).*
8 Accordingly, Fisher's apparatus does not transfer information to subscribers *in advance*
9 *of receiving requests from the subscribers to modify the information.* As stated in
10 Applicant's prior Response, this distinction represents a significant difference in design
11 philosophy between the system of claim 1 and Fisher's system. The system of claim 1
12 supplies local information to subscribers from which they may subsequently generate
13 requests; in marked contrast, Fisher's system relies on a traditional central database 30 to
14 orchestrate the sale of merchandise.

15 Accordingly, the Applicant submits that claim 1 is allowable over the Fisher
16 patent. The remaining active claims depend from claim 1, and are therefore allowable for
17 at least this reason.

18 The claims were alternatively rejected under § 102 by Lawrence (U.S. Patent No.
19 5,915,209). Applicant respectfully traverses this rejection for the following reasons, in
20 conjunction with the more expanded explanation set forth in the July 16, 2004 Response
21 (which is incorporated here by reference).

22 Lawrence discloses a system in which a selling trader 14 transmits one or more
23 job lots 16 of bonds for sale to a trading system 10 maintained by a broker, who functions
24 as a "market-maker." After appropriate central processing, solicitations for bids are
25 circulated to bidding traders 12. Bids 18 are received from one or more of the bidding

1 traders 12 and transmitted to the selling trader 14. See col. 6, lines 6-25 of Lawrence. As
2 stated in col. 3, lines 43-48, transmission of "bids to the market-maker from the bidders
3 must be confidential so that bids are not disclosed to other bidders."

4 Lawrence's system is therefore very different from the invention recited in
5 independent claim 1. For example, Lawrence does not disclose at least the following
6 element of claim 1 (in the context of claim 1 considered as a whole): "a publishing
7 component configured to select, *based on pre-established selection criteria*, for each of a
8 plurality of subscribers, a set of information from the information tracking component,
9 and to communicate the selected set of information to local storage maintained by the
10 subscriber, wherein the publishing component is configured to perform the
11 communication by *transferring the information to subscribers in advance of receiving*
12 *requests from the subscribers to modify the information.*" For example, Lawrence's
13 trading system 10 does not select, based on pre-established selection criteria, for each of
14 the plurality of bidding traders 12, a set of information, and then communicate that
15 information to the bidding traders 12.

16 Lawrence also does not disclose the following element of claim 1 (in the context
17 of claim 1 considered as a whole): "wherein the publishing component is further
18 configured to identify one or more of the plurality of subscribers affected by the
19 modification to the information stored in the information tracking component, and to
20 communicate, to the one or more of the plurality of subscribers affected by the
21 modification, the information as modified." Namely, Lawrence's secret auction
22 presumably *conceals changes* made by one bidder to other bidders (col. 3, lines 42-47),
23 whereas the invention recited in claim 1 communicates the information as modified to the
24 subscribers affected by the modification.
25

1 Accordingly, the Applicant submits that claim 1 is allowable over the Lawrence
2 patent. The remaining active claims depend from claim 1, and are therefore allowable for
3 at least this reason.

4 In making the rejections, the Patent Office also relies on various legal positions.
5 One such position is that, even if not expressly disclosed, the claimed elements are
6 inherent to Fisher (note paragraph No. 22 of the Office Action). However, as stated in
7 MPEP § 2112, in relying upon the theory of inherency, the Examiner must provide a
8 basis in fact and/or technical reasoning to reasonably support the determination that the
9 allegedly inherent characteristic necessarily flows from the teachings of the applied prior
10 art. This requirement has not been met in the Office Action. Further, this requirement
11 *cannot be met*, because, as described above, Fisher and Lawrence expressly disclose
12 apparatuses which function in a different manner than the claimed invention.

13 Further, in paragraph No. 27, the Patent Office asserts that the numerous
14 "configured to" clauses in the claims have not been given patentable weight. The
15 Examiner's general statement of law is correct; namely, as set forth in MPEP § 2114, an
16 *apparatus* claim must include structural details which distinguish the claimed invention
17 over the applied art. However, the application of this law to the claims in question is
18 both factually and legally misplaced.

19 Namely, *one* non-limiting way the claimed system can be implemented is by
20 providing logic (e.g., software, firmware, etc.) that can implement the functions described
21 in the claims. Note, for example, page 32, lines 21-28 of the specification. In this type of
22 invention, a claim element which recites "XYZ module configured to perform function
23 ABC" *does* reflect a structural difference, as this language ultimately refers to the
24 tangible logic used to implement this function. Consider *In re Alappat*, 33 F.3d 1526, at
25 1545 (Fed. Cir. 1994) ("We have held that programming creates a new machine, because

1 a general purpose computer in effect becomes a special purpose computer once it is
2 programmed to perform particular functions pursuant to instructions from program
3 software”) Note also *In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) (data structures
4 designed to permit computer to run more efficiently “impart a physical organization on
5 the information stored in memory”). While these two decisions pertain to the proper
6 application of 35 U.S.C. § 101, the conclusions reached therein also have obvious bearing
7 on what claim elements should be given weight in the context of making prior art
8 rejections under § 102 and § 103.

9 More specifically, the use of the phrase “configured to” in a logic-related
10 invention has a different meaning than the use of this term in a mechanical invention. By
11 analogy, if Applicant had claimed a can opener for use in opening a can of product A,
12 this subject matter would not distinguish over prior art that showed the *same can opener*
13 being used to open a can of product B. *But once again, in a logic-implemented invention,*
14 *that a component is “configured to” perform a stated function reflects an actual*
15 *structural difference that must be given patentable weight in examination.*

16 The ultimate consequence of the Examiner’s reasoning is that it is impermissible
17 for the Patent Office to allow any apparatus claim that defines a logic-implemented
18 invention (e.g., that defines a software-implemented invention). But the Patent Office
19 obviously does properly grant such types of patents. Indeed, at the time of drafting this
20 Response, a search of the Patent Office’s online electronic database indicates that there
21 are 935 issued patents in class 705 alone which use the term “configured to” in the
22 claims. For example, consider claim 15 of commonly assigned U.S. Patent No.
23 6,873,972 (with emphasis added):
24
25

1 15. A system for tracking bank credit lines and borrowing against the bank credit lines
2 using a Credit Line System, wherein the bank credit lines are established between a borrower and
3 at least one bank, said system comprising:

4 a server system, a client system configured with a browser, and a centralized database
5 coupled to said server system, said server system connected to said client system, *said server*
6 *system configured to:*

7 track credit ratings of a first bank;

8 access the centralized database to obtain and maintain information regarding a line of
9 credit established between the borrower and the first bank including the credit ratings of the first
10 bank, a total credit line, an amount drawn on the established line of credit, an interest rate on the
11 established credit line, and commitment fees associated with the established line of credit;

12 automatically transmit domestic and international wire information for cash movement to
13 the first bank to facilitate repayment by the borrower of the amount drawn on the established line
14 of credit and to ensure timely payment by the borrower of commitment fees associated with the
15 established line of credit;

16 monitor the established line of credit based on the credit ratings of the first bank;

17 calculate an eligibility factor for the borrower based on information stored in the
18 database, the eligibility factor indicating at least one of a likelihood that the first bank would
19 increase the established line of credit with the borrower and a likelihood that a second bank would
20 establish a new line of credit with the borrower; and

21 post journal entries to a general ledger of the borrower including borrowings against the
22 established line of credit, repayments made toward the established line of credit, and commitment
23 fees paid for the established line of credit for financial monitoring, reporting and auditing
24 purposes.
25

1 It is thus readily apparent that the term "configured to" in the context of logic-
2 implemented inventions is an acceptable way to claim these inventions. Therefore, it is
3 improper for the Patent Office to simply ignore the claim elements presented in the
4 claims of this application that use this phraseology. Failure to address this subject matter
5 does not allow the Applicant to assist the Examiner in advancing the prosecution of this
6 case, as the Applicant is not properly notified of the state of the prior art with respect to
7 the subject matter in these claims. Consider, for example, the new claims (i.e., claims 38-
8 47) added in the July 16, 2004 Response; the Patent Office has not identified how the
9 applied art meets *any* aspect of this *very detailed* subject matter. As set forth above, the
10 claim features cannot be ignored simply because they are phrased using the "configured
11 to" claim construction.

12
13 *Regarding the 35 U.S.C. § 103 Rejection*

14 Claims 1-6, 8-10, 12-19 and 38-47 were rejected under 35 U.S.C. § 103(a) as
15 being unpatentable over Fisher in view of Lawrence. Applicant respectfully traverses
16 this rejection for the following reasons.

17 The individual deficiencies of Fisher and Lawrence were pointed out above. The
18 Applicant further submits that, when combined together, Fisher and Lawrence still fail to
19 disclose or suggest the claimed invention. For instance, even when combined, these two
20 references fail to disclose the following element of claim 1 (when considered in the
21 context of the claim as a whole): "a publishing component configured to select, based on
22 pre-established selection criteria, for each of a plurality of subscribers, a set of
23 information from the information tracking component, and to communicate the selected
24 set of information to local storage maintained by the subscriber, wherein the publishing
25 component is configured to perform the communication by transferring the information

1 to subscribers in advance of receiving requests from the subscribers to modify the
2 information."

3 Moreover, there is no suggestion to combine Lawrence and Fisher together.
4 Lawrence emphasizes the use of a secret bidding environment which proceeds "without
5 revealing bids to other bidders in a broker-conducted auction" (column 19, line 67 to
6 column 20, line 1). This appears to be contrary to the Fisher's design objectives, and
7 therefore there would be no motivation to supplement Fisher by adding the features of
8 Lawrence.

9 Accordingly, the Applicant submits that claim 1 is allowable over the
10 combination of Fisher and Lawrence. The remaining active claims depend from claim 1,
11 and are therefore allowable for at least this reason.

12 For at least the above-identified reasons, the Applicant respectfully requests that
13 the rejections under 35 U.S.C. § 103 be withdrawn.

14
15 *Miscellaneous Issues*

16 The Office Action contains a large amount of seemingly general-purpose legal
17 analysis regarding claim interpretation and other legal issues. To assist the Examiner,
18 Applicant has endeavored to reply to specific issues which have a direct bearing on the
19 pending claims (such as the issue of what patentable weight should be given to the phrase
20 "configured to.") Other portions of the legal analysis seem to have, at best, a remote
21 bearing on the case; for instance, the meaning of the terms "server" and "client" seems to
22 have limited bearing, as these terms do not appear in the claims. In any event, the
23 Applicant agrees, of course, that the claims should be interpreted according to applicable
24 law, which, in any case, involves a consideration of both the specification and the plain
25 meaning of words. But Applicant does not concede to any PTO-dictated redefinition of

1 the claim language which may inappropriately restrict these claims to "special" or
2 idiosyncratic interpretations of the claims that were not intended by Applicant.

3 As a final matter, the Applicant informs the Patent Office that the following
4 commonly-assigned applications were filed on the same date as the present application:
5 09/847,063; 09/845,752; 09/845,751; 09/847,067; 09/845,737; 09/845,780; 09/847,038;
6 and; 09/847,037.

7
8 *Conclusion*

9 The arguments presented above are not exhaustive; Applicant reserves the right to
10 present additional arguments to fortify its position. Further, Applicant reserves the right
11 to challenge the prior art status of one or more documents cited in the Office Action.

12 All objections and rejections raised in the Office Action having been addressed, it
13 is respectfully submitted that the present application is in condition for allowance and
14 such allowance is respectfully solicited. The Examiner is urged to contact the
15 undersigned if any issues remain unresolved by this Amendment.

16
17
18 Respectfully Submitted,

19
20 Dated: June 10, 2005

21 By: David M. Huntley

22 David M. Huntley
23 Reg. No. 40,309
24 (509) 324-9256
25